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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/529,211 | 01/17/2006 | Bo E. Samuelsson | 19200-000045/US | 2024 |
| 36593 7590 02/21/2008 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195 | | | | |
| EXAMINER | | | | |
| NGUYEN, CAMTU TRAN | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3772 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 02/21/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,211

Applicant(s)

SAMUELSSON, BO E.

Examiner

Camtu T. Nguyen

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to RCE

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's claims filed on 9-27-2007 has been entered. Claims 1, 3, and 4 have been amended.

Applicant's comments directed to the primary reference to Blake applied in the previous Office Action have been carefully considered and deemed persuasive, particularly as lacking the teaching of the glue. Thus, the rejection based on the primary Blake reference rejection has been vacated.

Specification

The amendment filed on 9-27-2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: new paragraph added on page 6 line 34 disclosing a material that is designed/provided to rupture upon ejaculation, such material is not supported by the original specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 & 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, in claim 1, the material of the second part, referred by numeral (4) in the specification & drawing, particularly the material of that is designed to rupture upon ejaculation is not detailed in the specification. One skilled in the art would not be enabled to make the invention without knowing the material of the second part, specifically, the material designed to rupture upon ejaculation. In claim 8, the specification does not detail second component of the glue other than it is contrived to be applied to the man's glans (page 6 lines 10-12), one skilled in the art would not be enabled to make this second component of the glue, specifically, in order to create a strong adhesion upon contact with the first component since the material of the second component is not named.

Claims 2 & 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Particularly, the limitation "a more brittle portion" in claim 1 is not supported by the specification. The limitation "non-adhesive" in claim 8 is not supported by the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Herr (U.S. Patent No. 5,458,114). Herr discloses a penile cap (1) comprising a bowl (3) and a seminal bladder (4), both of which are made from elastic material (column 3 lines 12-15 & lines 45-49), the bowl (3) has an inner side or the lower surface (9) coated with a layer of adhesive (14) to secure the cap (1) to the penile glans (10), see column 3 lines 23-33. With regards to claim 1 reciting the material of the second portion that is designed to rupture upon ejaculation, the elastic material of the bladder (4) is rupturable. With regards to claim 2 reciting second part the stiffer portion and the more brittle portion without explicitly reciting a specific material, the Herr reference discloses the thickness of the seminal bladder (4) preferably between 0.001 and 0.008 of an inch, most preferably about 0.005 of an inch (column 49-52), thus, providing the flexibility such that seminal bladder (4) capable of comprising a stiffer portion and a more brittle portion, as recited, without departing from the scope of the invention. With regards to claim 3, the Herr discloses in Figure 5 lower surface (9) of bowl (3) is substantially a bending disk wherein the outer

circumference of the bowl (3) is less than the circumference of the normal-sized erect glans, the middle part of the bowl merges into the seminal bladder (4), and the bowl (3) is dimensioned/configured to be fixed over the urethral orifice (11). With regards to claim 4, since “normal-sized erect glan” varies from person to person, hence, the Herr bowl (3) is essentially dimension/configured as large as a normal-sized erect glan for a person with a smaller sized erect glan.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herr (U.S. Patent No. 5,458,114). Herr discloses a penile cap (1) comprising a bowl (3) and a seminal bladder (4), presented above. With regards to claim 5, the Herr reference discloses the layer of adhesive (14), which functions similarly in manner to that of a bandage having adhesive, retains fastening capacity of the penile cap (1) to the glans skin under action of normal bodily fluids. With regards to claims 6 & 7, it is well known in the art that ethanol can be used to remove glue or tacky substances. In fact, applicant discloses its availability in the specification on page 6 lines 16-20. Therefore, it would have been obvious to one skilled in the art at the time of the invention to employ the well known technique, including applicant's own admission that it is known, to utilize ethanol as the solvent agent to remove the adhesive from the device of Herr when one

chooses to dissolve the glue. With regards to claim 8, the Herr reference discloses the first component in the form of a removable protective cover (21) as shown in Figure 5, the cover (21) is preferably made from a thin sheet of paper, rubber, plastic or similar material which is easily peeled away from the adhesive layer (14) prior to installation (column 4 lines 42-53). The Herr does not disclose the second component recited in claim 8. However, since applicant's specification does not disclose what the second component is other than it is to be applied to the man's glans (page 6 lines 9-12), thus providing no criticality to the composition of the second component, it would have been obvious to one skilled in the art at the time of the invention to have used a skin glue, as it is sometimes called in the field, as the second component to be administered on the user's penile glans such that fix the penile cap device to the user's penile glans (10). Skin glue is a known copolymer of an acrylic ester and acrylic acid used in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,955,392 (Sorkin) discloses a common skin glue, referred in the art as copolymer of an acrylic ester and acrylic acid (column 4 lines 38-40).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camtu T. Nguyen whose telephone number is 571-272-4799. The examiner can normally be reached on (M-F) 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Camtu T. Nguyen/
Examiner, Art Unit 3772

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772